



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/987,194	11/13/2001	Makoto Inoue	206-019-01	6160
21254	7590	01/16/2007	EXAMINER	
MCGINN INTELLECTUAL PROPERTY LAW GROUP, PLLC 8321 OLD COURTHOUSE ROAD SUITE 200. VIENNA, VA 22182-3817			O'CONNOR, GERALD J	
			ART UNIT	PAPER NUMBER
			3627	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		01/16/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)
	09/987,194	Inoue et al.
	Examiner O'Connor	Art Unit 3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on September 5, 2006 (RCE & Amdt) and July 28, 2006 (Amdt).
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-23 is/are pending in the application.
 4a) Of the above claim(s) 9-22 is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-8 and 23 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on November 13, 2001 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>20060905 and 20061026</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submissions filed on July 28, 2006 and September 5, 2006 have been entered.

Preliminary Remarks

2. This Office action responds to the amendment and arguments filed by applicant on July 28, 2006, and to the supplemental amendment filed by applicant on September 5, 2006, both in reply to the previous Office action on the merits, mailed April 5, 2006.

3. The amendment of claims 1 and 2 by applicant in the reply filed July 28, 2006 is hereby acknowledged.

4. The addition of claim 23 by applicant in the reply filed September 5, 2006 is hereby acknowledged.

Response to Amendment

5. The amendment submitted September 5, 2006 fails to comply with 37 CFR 1.121(c) because it fails to indicate any changes to “currently amended” claims 1 and 2 and because it fails to indicate the correct status (“currently amended”) for claims 1 and 2. The paper has been entered, but all future amendments *must* comply with 37 CFR 1.121.

Applicant’s Interview Summary

6. The interview summary included by applicant in the reply submitted September 5, 2006 is not agreed with because it mischaracterizes the examiner’s stated position regarding the finality of any future Office actions responsive to the amendment, if the amendment were to be entered. In fact, the examiner merely stated that the appropriateness of a first-action-final rejection would be “considered” in view of applicant’s amendment and remarks, not that any Office action “would necessarily” be made non-final.

Upon review of applicant’s amendments and remarks submitted July 28, 2006 and September 5, 2006, the examiner agrees with applicant’s stated position that “such amendments do not raise a new issue requiring a further search and/or consideration by the Examiner” (page 11, lines 13-14, of applicant’s remarks of July 28, 2006). Based on this stated characterization/position of applicant as to the lack of substance in the amendment, which position is agreed with by the examiner, the finality of this Office action is therefore considered appropriate.

Election/Restriction

7. Claims 9-22 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a non-elected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed July 8, 2005.

Priority

8. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan on November 13, 2000. It is noted, however, that applicant has not filed a certified copy of the Japanese application as required by 35 U.S.C. 119(b).

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- (e) the invention was described in
 - (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
 - (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

10. Claims 1-8 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Gardner et al. (US 5,758,327).

Gardner et al. disclose a system for purchase management based on the administrative standard of purchasing, said system comprising: an administrative standard specifying unit for specifying, when a purchase request is to be made on a plurality of types of items, the administrative standard of the purchase request according to the expense items representing the category or use of said items defined for each item (see, in particular, column 5, line 57, to column 6, line 13), by defining useable expense item codes based upon a correlation between a budget control unit for a user and said expense items (see, in particular, column 6, lines 64-67); an administrative standard specific dividing controller for performing control of dividing said purchase request per administrative standard when said administrative standard specifying unit specifies that the administrative standards of the respective items to which the purchase request was made differ; an administration controller for receiving the purchase request divided per administrative standard and administratively controlling said purchase request; a divided ordering controller for performing control of dividing and ordering said purchase request per item specific dealer when said administration controller allows the purchase request; and an order totaling controller for totaling the order data ordered by the divided ordering controller according to the attribute of the expense item of said order (see, in particular, column 6, line 27, to column 9, line 56).

Regarding claim 2, the system of Gardner et al. further comprises: an expense item code displaying controller for selectively displaying, at the time of said purchase request, the expense item code defined in the budget control unit to which the user making the purchase request of items belongs, and the expense item code set forth per category of said items or per price decision method of said items; and an expense item specifying unit for inputting, among one or a plurality of expense item codes displayed selectively, the expense item code specified when the user makes the purchase request as the expense item of said item as said administrative standard specifying unit.

Regarding claim 3, in the system of Gardner et al. the administrative standard specifying unit comprises a user specific administrative standard specifying function, and this function specifies said administrative standard according to the budget control unit to which said user belongs and said expense item.

Regarding claim 4, in the system of Gardner et al. the administrative standard specifying unit comprises a path specifying function, and this function specifies as said administrative standard the budget control unit identification for identifying one or a plurality of budget controlling divisions, or the budget control unit identification for identifying a plurality of budget/approval controlling divisions.

Regarding claim 5, in the system of Gardner et al. the divided ordering controller comprises an item specific ordering controller for transmitting said order data per said item specific predetermined dealer.

Regarding claim 6, in the system of Gardner et al. the user specifies a purchasable item group per user making the purchase request of items, and further comprising an item accessing controller for controlling the display of items per respective user in accordance with said purchase availability.

Regarding claim 7, in the system of Gardner et al. the item accessing controller comprises a function of determining the purchase availability per said user based on merchandise assortment related information for specifying the merchandise assortment set forth per said respective user or user group.

Regarding claim 8, in the system of Gardner et al. the item accessing controller comprises a function of determining the purchase availability per said user based on the predetermined purchasable expense item per said respective user or user group.

Response to Arguments

11. Applicant's arguments filed July 28, 2006 have been fully considered but they are not deemed persuasive.

12. To the extent that applicant is arguing that the references applied in the rejection fail to use the exact same names/words for certain elements as the names/words used by applicant (e.g., "expense items," etc.), the argument is irrelevant, as it is noted that the disclosure in a reference must show the claimed elements arranged in the same manner as in the claims, but need

not be in the identical words as used in the claims in order to be anticipatory. See *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990).

13. To the extent that applicant is arguing claimed recitations comprising functional language, note that recited functional language is ordinarily deemed merely intended usage of an invention, hence, afforded little patentable weight. Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). “[A]pparatus claims cover what a device *is*, not what a device *doesHewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). A recitation of an intended use of a claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). See MPEP §2114.

14. Regarding the argument that the system of Gardner et al. is not capable of totaling the order, the system of Gardner et al. is indeed clearly capable of totaling the order.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to the disclosure.

16. All rejected claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

17. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, **Jerry O'Connor**, whose telephone number is **(571) 272-6787**, and whose facsimile number is **(571) 273-6787**.

Official replies to this Office action may now be submitted electronically by registered users of the EFS-Web system. Information on EFS-Web tools is available on the Internet at: <http://www.uspto.gov/ebc/portal/tools.htm>. An EFS-Web Quick-Start Guide is available at: <http://www.uspto.gov/ebc/portal/efs/quick-start.pdf>.

Alternatively, official replies to this Office action may still be submitted by any *one* of fax, mail, or hand delivery. **Faxed replies should be directed to the central fax at (571) 273-8300.** Mailed replies should be addressed to "Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450." Hand delivered replies should be delivered to the "Customer Service Window, Randolph Building, 401 Dulany Street, Alexandria, VA 22314."

GJOC

January 8, 2007



1/8/07

Gerald J. O'Connor
Primary Examiner
Group Art Unit 3627